

REMARKS

Claims 1-10 are pending in the application. Reexamination and reconsideration are respectfully requested. Per the Examiner's request, Applicants have submitted herewith a substitute specification under 37 C.F.R. §1.125(a). This substitute specification contains only subject matter from the original specification and any previously entered amendment. No new matter is added.

In the Office Action, the Examiner rejected claims 1, 2, 8 and 9 under 35 U.S.C. §103(a) as being unpatentable over NAKAMOTO et al. (US 4,561,527) in view of the admitted prior art disclosed in paragraph 5 on page 2 of the instant application. Applicants respectfully traverse this rejection. Initially, Applicants note that this §103 rejection appears to be a verbatim statement of the §102 rejection made in the prior Office Action of February 5, 2004. The sole change appears to be that the rejection is now made under §103(a) as opposed to §102(b). Nevertheless, as pointed out in Applicants' prior reply, such a §103 rejection is likewise improper.

In that regard, Applicants point out that even a combination of NAKAMOTO et al. in view of the "admitted prior art" does not read on Applicants' claimed invention. Applicants' independent claim 1 recites a system comprising both a motor vehicle startable without a mechanical key and an automatically activated parking brake system for such a motor vehicle. The automatically activated parking brake system includes an electronic control unit

for automatically activating a parking brake in dependence on at least one specified operating parameter of the vehicle. Importantly, means for arbitrarily preventing the control unit from automatically activating the parking brake when the activation would otherwise occur based on the at least one specified operating parameter is also provided.

The Examiner references col. 6, lines 34-41 of NAKAMOTO for allegedly meeting the “means for arbitrarily preventing...” limitation. However, that passage refers to a controller provided with an “automatic control prohibition circuit 37”. That circuit does not “arbitrarily” prevent activation, but rather automatically does so upon the occurrence of certain events as specified in col. 6, lines 34-45. Hence, for this additional reason, even a combination of NAKAMOTO in view of Applicants’ admitted prior art does not obviate Applicants’ invention.

Finally, Applicants respectfully submit the rejection is improper as it is based on impermissible hindsight, among other reasons. While Applicants agree that vehicles startable without mechanical keys are an advancement over vehicles that require mechanical keys, that fact alone does not suggest the combination discussed in the Office Action. Applicants’ invention solves a problem wherein mechanical key vehicles automatically activate a parking brake at the latest upon removing the ignition key from the lock (see paragraph 3). To achieve the same functionality in a keyless system, various legal requirements have resulted in an automatically activated parking brake that activates the brake in dependence on at least one other operating parameter or

operating state of the vehicle. Of course, this presents a problem which the present invention overcomes, that is, undesirable activation of the parking brake can sometimes occur. The present invention provides a means for arbitrarily preventing the automatic activation. NAKAMOTO, for that matter, neither recognizes the problem addressed by Applicants' invention nor does it attempt to solve it. Hence, any combination of NAKAMOTO with a keyless vehicle is merely the impermissible piecing together of Applicants' claim based on the teachings described in their specification. Such a hindsight rejection would be improper. As the court stated in W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Accordingly, Applicants submit claims 1, 2, 8 and 9 are patentable over NAKAMOTO et al. in view of the admitted prior art.

Applicants gratefully acknowledge the indicated allowability of claims 3, 4, 7 and 10. However, as these claims depend from claims 1 and 8, which are now submitted to be allowable, Applicants have not rewritten these claims into independent form at this time.

For the foregoing reasons, Applicants submit claims 1-10 are in condition for allowance. An early notice to that effect is solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #951/50202).

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Respectfully submitted,



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